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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,883	03/12/2001	Leo I. Rainer	00-240	5679

7590 10/09/2003
William S. Bernheim
255 N. Lincoln St.
Dixon, CA 95620

EXAMINER

CIRIC, LJILJANA V

ART UNIT PAPER NUMBER

3753

DATE MAILED: 10/09/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Art Unit: 3743

Response to Amendment

1. This Office communication is in response to the amendment and arguments and request for drawing changes [Paper No. 10], filed on June 25, 2003, and the supplemental amendment [Paper No. 11], filed on August 1, 2003. Receipt of these papers is hereby acknowledged.
2. Nevertheless, the abovementioned papers submitted by the applicant are not fully responsive to the prior Office Action because of the following omission(s) or matter(s): the amendments to the specification, claims and drawings as presented via the amendments filed on June 25, 2003 and on August 1, 2003 are not in compliance with the versions of 37 CFR 1.121(c) in effect at the time of filing of the respective amendments. In particular, no marked up copy and no clean copy of the portions of the specification being amended were provided with the amendment filed on June 25, 2003, and the amendment attempts to replace claim 1 with a new claim 1 without presenting a marked-up copy showing the specific changes to claim 1 being incorporated thereby as required; also, new drawings were presented without either a marked-up copy showing the proposed changes or a description of the particular changes made to the original drawings. The supplemental amendment does not include a complete listing of all of the existing claims in the application as required for all amendments to the claims filed on or after July 30, 2003. The above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Art Unit: 3743


3. ***NOTE: ALL amendments filed on or after July 30, 2003, including any response to the instant Office communication, MUST comply with the newly revised amendment practice in accordance with 37 CFR 1.121 which became effective on July 30, 2003,*** which version is different from the version in effect as of the filing date of Paper No. 10. See Attachments (A), (B), and (C) hereto for more guidance and information regarding the abovementioned revised amendment practice.
4. A single **replacement** amendment for Paper No. 10 and for Paper No. 11 which is in full compliance with the revised version of 37 CFR 1.121 effective July 30, 2003 would constitute a proper response to the instant Office communication.
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ljiljana (Lil) V. Ciric, whose telephone number is (703) 308-3925. While she works a flexible schedule that varies from day to day and from week to week, Examiner Ciric may generally be reached at the Office during the work week between the hours of 10 a.m. and 6 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Scherbel, can be reached on (703) 308-1272. The fax phone number is (703) 305-3463.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0861.

lvc

October 7, 2003


LJILJANA V. CIRIC
PRIMARY EXAMINER
ART UNIT 3753

SAMPLE FORMAT FOR REVISED AMENDMENT PRACTICE (Rev. 6/03)

Appl. No. : XX/YYY,YYY Confirmation No. WXYZ
Applicant : James Q. Inventor
Filed : April 19, 2003
TC/A.U. : 1744
Examiner : John Doe
Docket No. : 12345/JAS/R758
Customer No. : 88888

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

AMENDMENT

Sir:

In response to the Office action of October 16, 2003, please amend the above-identified application as follows:

Amendments to the Specification begin on page 2 of this paper.

Amendments to the Claims are reflected in the listing of claims which begins on page 3 of this paper.

Amendments to the Drawings begin on page 4 of this paper and include both an attached replacement sheet and an annotated sheet showing changes.

Remarks/Arguments begin on page 5 of this paper.

An **Appendix** including amended drawing figures is attached following page 5 of this paper.

Amendments to the Specification:

Please replace paragraph [0021] with the following amended paragraph:

[0021] In the construction of the bucket of this invention, various materials have been selected ~~[[and]]~~ which offer a number of diverse properties ~~[[,]]~~ and allow for varied functions of the article. For caustic solutions, the bucket can be made of a durable ~~polymer~~ plastic material. Where an aesthetic appeal is desired, the bucket can be any ~~[[of]]~~ one of many attractive colors. The following ~~listing~~ list of properties serves to define possible uses for the buckets.

Please replace paragraph [0045] with the following amended paragraph:

[0045] Figure 1 displays a bucket of the invention. As can be seen from the drawing, ~~the~~ a handle is attached to the upper lip of the structure and connected at points diametrically opposite each other on the circumference.

Please add the following new paragraph after paragraph [0075]:

[0075.1] An optional feature of the articles of the invention is the addition of a tetrafluoroethylene coating to the bucket to provide protection from any contents which might be caustic. The coating can be provided to the surface during the manufacturing process or can be added in a later step.

Please delete the paragraph beginning at page 2, line 4, which starts with "Under normal circumstances"

Amendments to the Claims:

This listing of claims will replace all prior versions, and listings, of claims in the application:

Listing of Claims:

Claims 1-5 (canceled)

Claim 6 (previously presented): A bucket with a handle.

Claim 7 (withdrawn): A handle comprising an elongated wire.

Claim 8 (withdrawn): The handle of claim 7 further comprising a plastic grip.

Claim 9 (currently amended): A bucket with a ~~green~~ blue handle.

Claim 10 (original): The bucket of claim 9 wherein the handle is made of wood.

Claim 11 (canceled)

Claim 12 (not entered)

Claim 13 (new): A bucket with plastic sides and bottom.

Appl. No. XX/YYY,YYY
Amdt. dated Jan. 15, 2004
Reply to Office action of Oct. 16, 2003

Amendments to the Drawings:

The attached sheet of drawings includes changes to Fig. 2. This sheet, which includes Fig. 1-2, replaces the original sheet including Fig. 1-2. In Figure 2, previously omitted element 13 has been added.

Attachment: Replacement Sheet
 Annotated Sheet Showing Changes

REMARKS/ARGUMENTS

In the specification, the paragraphs [0021] and [0045] have been amended to correct minor editorial problems. The new paragraph [0075.1] added after paragraph [0075] discusses in general terms the features taken from Example 4.

In amended Figure 2, the previously omitted element numeral 13 has been added.

Claims 6-10 and 12-13 remain in this application. Claims 1-5 and 11 have been canceled. Claims 7 and 8 have been withdrawn.

The examiner has acknowledged that claims 6 and 9-10 are directed to allowable subject matter. Claim 7-8 have been withdrawn as the result of an earlier restriction requirement. Claim 13 adds an additional feature from Example 2 in the specification.

In view of the examiner's earlier restriction requirement, applicant retains the right to present claims 7-8 in a divisional application

.....
.....

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

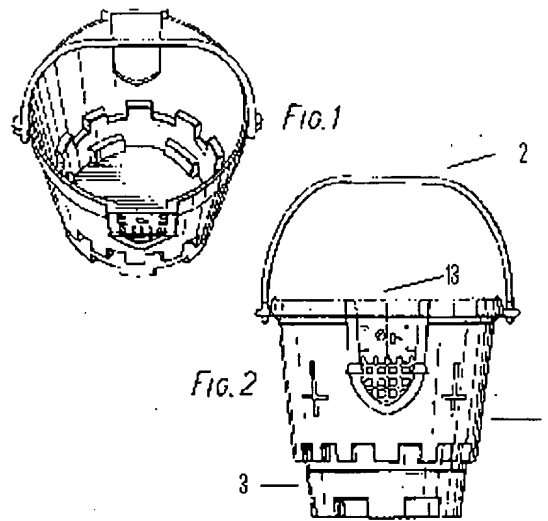
Respectfully submitted,

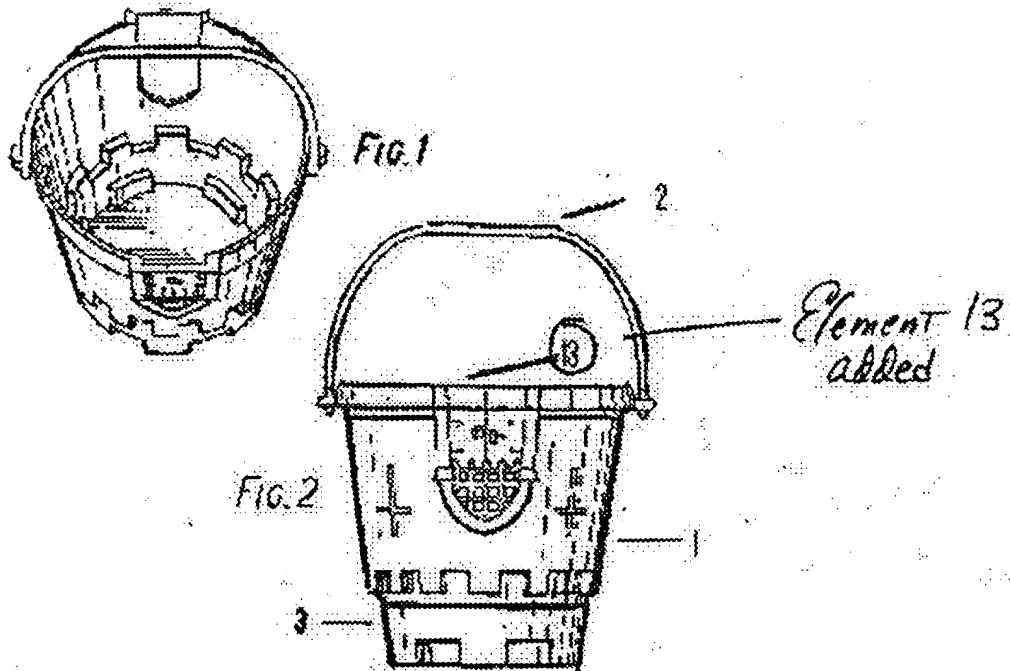
SMITH, JONES & BROWN

By _____
Martin J. Gallagher
Reg. No. 99,999
Tel.: (101) 555-2345

Attachments

Appl.No. XX/YYY,YYY
Amdt. Dated Jan. 15, 2004
Reply to Office action of Oct. 16, 2003
Replacement Sheet





United States Patent and Trademark Office OG Notices: 23 September 2003

Amendments Permitted under the
Revised Amendment Practice and
Treatment of Non-Compliant Amendments

SUMMARY:

Amendments submitted prior to July 30, 2003 in compliance with the previous version of 37 CFR 1.121 or the revised version promulgated in the Notice of Final Rule Making: Changes To Implement Electronic Maintenance of Official Patent Application Records, 68 Fed. Reg. 38611 (June 30, 2003) (Revised Amendment Practice) will be accepted. Amendments filed on or after July 30, 2003, must be submitted in compliance with revised 37 CFR 1.121. The previously announced limited waivers permitting submission of amendments in the voluntary revised amendment format terminate on July 29, 2003. If a preliminary amendment or a reply under 37 CFR 1.111 filed on or after July 30, 2003 includes one or more non-compliant sections, applicant will be notified via a Notice of Non-Compliant Amendment that the non-compliant section(s) needs to be re-submitted in compliant form within a period set by the Office.

BACKGROUND

The United States Patent and Trademark Office (Office) previously announced a prototype program to evaluate the electronic image processing of patent applications using the image file wrapper system (IFW). See USPTO Announces Prototype of Image Processing, 1265 Off. Gaz. Pat. Office 87 (December 17, 2002). The notice included a limited waiver of 37 CFR 1.121 (available in applications being examined in the prototype program) which permitted amendments to be submitted in a voluntary revised amendment format. The limited waiver was later extended to all applications. See Amendments in a Revised Format Now Permitted, 1267 Off. Gaz. Pat. Office 106 (February 25, 2003). The Office revised its rules of practice to implement image file wrapper processing, including the Revised Amendment Practice, taking into account public comments, in the above-noted notice of final rule making, which is effective on July 30, 2003. Many members of the public have requested that the Office permit amendments to be submitted in compliance with the revised version of 37 CFR 1.121 before the effective date of July 30, 2003 in order to provide for a smoother transition to the new practice. This Notice adopts the suggestion.

WAIVER OF 37 CFR 1.121 UNTIL JULY 29, 2003

The provisions of 37 CFR 1.121(a), (b), (c) and (d) are hereby waived for amendments to the claims, specification, and drawings, filed before July 30, 2003 in all applications where the amendments comply with 37 CFR 1.121 effective on July 30, 2003. Note: The revised amendment rules (and this waiver) do not apply to 37 CFR 1.121(h) and (i) which indicate that amendments to reissue applications and reexamination proceedings are governed by 37 CFR 1.173 and 37 CFR 1.530(d)-(k), respectively.

TREATMENT OF NON-COMPLIANT AMENDMENTS

All amendments received by the Office on or after July 30, 2003 must be in compliance with the rules as required by the Revised Amendment Practice. This practice requires the submission of an amendment document that includes separate sections for amendments to

the claims, drawings, specification and abstract, each beginning on a new sheet of paper. If an amendment is received as a preliminary amendment or as a bona fide reply under 37 CFR 1.111, that has compliant amendments to one or more separate section(s), but also includes one, or more, separate section(s) with non-compliant amendments, the Office will mail a Notice of Non-Compliant Amendment requiring correction to the non-compliant section(s) within a time period set by the Office. When making corrections, applicant should just resubmit the needed corrected section(s), and correspondingly, should not resubmit the entire amendment document. For example, if the amendment included compliant amendments to the specification and claims, and non-compliant amendments to the drawings, a notice requiring resubmission of compliant amendments to the drawings would be sent. In reply to the notice, applicant should only submit a compliant amendment to the drawings, and not the previously compliant amendments to the specification and claims. If any additional, or further, amendments to the claims are desired, the changes must be made relative to the previous compliant amendment to the claims. The Office will consider both the previous compliant amendment to the claims, and the supplemental compliant amendment to the claims, after the Office receives the compliant amendment to the drawings.

An amendment submitted on or after July 30, 2003 as part of a reply after the close of prosecution (e.g., as a reply under 37 CFR 1.116) that is not compliant with the Revised Amendment Practice will not act to toll the outstanding time period. See 37 CFR 1.135(c). A notice (e.g., an advisory action) may be mailed by the Office specifying which section(s) of the amendment was not in compliance with the Revised Amendment Practice, but no new time period will be given to provide a compliant section.

FOR FURTHER INFORMATION CONTACT:

Questions concerning this notice may be submitted to Joseph Narcavage, Elizabeth Dougherty or Eugenia Jones by e-mail at joseph.narcavage@uspto.gov or by telephone at (703) 305-1622.

July 11, 2003

STEPHEN G. KUNIN
Deputy Commissioner for
Patent Examination Policy



UNITED STATES PATENT AND TRADEMARK OFFICE

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Revised Amendment Practice

Questions & Answers (FAQs)

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A. Preliminary Amendments

A1. If an application is filed with a preliminary amendment to add several new claims, does the preliminary amendment have to include a complete listing of all claims in compliance with revised 37 CFR 1.121? (posted August 14, 2003)

Yes, the preliminary amendment must be filed in compliance with revised 37 CFR 1.121 with a complete listing of the claims. The new claims should have the status identifier, "new".

Applicant should not use the status identifier, "original" for the claims added in the preliminary amendment, even if the application was filed with an oath or declaration that has a statement referring to the preliminary amendment.

If applicant files a subsequent amendment that includes a complete listing of the claims, applicant should use the status identifier, "previously presented" (if the claims added in the preliminary amendment are not being amended), or "currently amended" (if the claims added in the preliminary amendment are being amended).

Filing an application with a preliminary amendment is not recommended. Applicants are encouraged to file the application with a specification that includes the desired set of claims. See File Continuation or Divisional Application with a New Specification and Copy of Oath or Declaration from Prior Application, 1251 Off. Gaz. Pat. Office 54 (October 9, 2001).

A2. Can I use the transmittal letter of a continuation or divisional application to amend the first sentence of the specification to add the benefit claim to the parent application? (posted August 14, 2003)

No, a preliminary amendment cannot be made in a transmittal letter or form for the filing of an application. The amendment to the specification that adds the specific reference to the parent application in the first sentence of the specification following the title must be provided on a separate sheet of paper in compliance with revised 37 CFR 1.121.

Applicant may wish to provide the specific reference in an application data sheet (ADS) under 37 CFR 1.76 or in a new specification instead of filing a copy of the specification of the parent application with a preliminary amendment.

The Office transmittal forms will no longer permit any preliminary amendment to be made in the transmittal form. If applicants are using a

transmittal form that provides a box for a preliminary amendment, applicants are advised not to use such box, but to provide the preliminary amendment on a separate sheet of paper in compliance with revised 37 CFR 1.121.

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B. Claims

B1. May I submit a complete claim listing in a reply when I am not making any changes to the claims, such as responding to a restriction requirement or merely arguing a rejection? (posted August 14, 2003)

Yes. Although a complete claim listing is only required whenever changes are made to any claims, one may be submitted in a reply to an Office action where no changes are being made. It is beneficial to the examiner (and all viewers of the electronic file) to have the most up-to-date set of claims in the most recent paper submitted by the applicant. Note that the claim listing in this situation would not include any claims with markings or any claims with the status identifiers of (new) or (currently amended).

B2. How should I amend a formula in a claim? (posted August 21, 2003)

Applicants may use one of the following methods, for example, change "H4" to "H2" in a chemical formula:

(1) Strikethrough and underlining the whole formula.

Claim 1 (currently amended) A curing agent for epoxy resins comprising pyromellitic dianhydride, C6H4 (C2O3)2 C6H2 (C2O3)2.

(2) Doublebrackets and underlining the whole formula.

Claim 1 (currently amended) A curing agent for epoxy resins comprising pyromellitic dianhydride, [[C6H4(C2O3)2]]C6H2 (C2O3)2.

(3) Delete the claim and replace it with a new claim.

Claim 1 (canceled).

Claim 2 (new) A curing agent for epoxy resins comprising pyromellitic dianhydride, C6H2 (C2O3)2.

Do not use strikethrough or doublebrackets to delete only subscript "4" and use underlining to add only subscript "2" in the formula.

B3. In the past, I have included claim status that indicates how many times a claim has been amended, i.e., "Claim 1 (Twice Amended)." Is it proper to indicate that a claim has been "previously amended twice" or "currently amended for the third time?" (posted August 21, 2003)

No, under the revised amendment practice, it would NOT be appropriate to indicate how many times a claim has been amended. Only the following seven status identifiers are permitted: "original", "currently amended", "canceled", "new", "withdrawn", "previously presented", and "not entered".

B4. May I submit a complete claim listing in a reply when I am not making any

changes to the claims, such as responding to a restriction requirement or merely arguing a rejection? (posted August 21, 2003)

Yes. Although a complete claim listing is only required whenever changes are made to any claims, one may be submitted in a reply to an Office action where no changes are being made. It is beneficial to the examiner (and all viewers of the electronic file) to have the most up-to-date set of claims in the most recent paper submitted by the applicant. Note that the claim listing would not include any claims with markings or any claims with the status identifiers of (new) or (currently amended).

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C. Drawings

C1. When I file an amendment to the drawings, do I need a Letter to the Office Draftsman? (posted August 14, 2003)

No, a Letter to the Office Draftsman is not required. The amendment to the drawings must include: (1) replacement figures which incorporate the desired changes, and (2) an explanation of the changes either in the drawing amendments or remarks section of the amendment.

C2. My drawings in the application have been objected to by the examiner. Should I submit proposed changes to the drawings in red for the examiner's approval before I submit the final version of the drawings? The attachment for PTO-948 that accompanies an office action entitled "Information on How to Effect Drawing Changes" provides that changes to drawings other than informalities noted by draftsperson requires a sketch with changes to be incorporated marked in red to be submitted. MPEP 608.02(v) also provides changes to be submitted in a similar way.

What procedure should I follow for the following? (posted August 21, 2003)

The proposed drawing correction practice has been discontinued. In order to comply with the revised amendment practice, applicant must submit replacement drawings with the desired changes already incorporated into the figures and label those sheets of drawings as replacement sheets. Changes should be discussed in the remarks section or the Amendment to the Drawings section of your amendment document. Additionally, applicants are permitted to submit (if desired), or the examiner may require, annotated drawings in addition to the replacement sheets if the changes being made are hard to discern or need further explanation. Redline markings are acceptable in annotated drawings. The Office will revise the PTO-948 and the MPEP 608.02(v) in accordance with the revised amendment practice.

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D. Effective Date

D1. If I filed an amendment under the previous version of 37 CFR 1.121 with a certificate of mailing date before July 30, 2003, the effective date of revised 37 CFR 1.121, but the Office received the amendment on or after July 30, 2003, would the amendment be accepted as a compliant amendment under 37 CFR 1.121? (posted August 14, 2003)

Yes, if the amendment is filed in compliance with the previous version of 37

CFR 1.121 with a certificate of mailing date before July 30, 2003, the amendment will be accepted as a compliant amendment. See Pre-OG notice, Amendments Permitted under the Revised Amendment Practice and Treatment of Non-Compliant Amendments (signed July 11, 2003) available on the USPTO website.

D2. I filed an after-final amendment in compliance with the previous version of 37 CFR 1.121 with a certificate of mailing date before July 30, 2003 and the amendment was not entered by the Office. I would like to file a request for continued examination (RCE) under 37 CFR 1.114 and have the after-final amendment to be entered as the submission for the RCE. If the RCE is filed on or after July 30, 2003, would the Office accept the after-final amendment as a compliant amendment when the amendment is entered as the submission for the RCE? (posted August 14, 2003)

Yes, if the after-final amendment is filed in compliance with the previous version of 37 CFR 1.121 with a certificate of mailing date before July 30, 2003, the Office will enter the amendment as a compliant amendment when the RCE is entered.

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E. National Stage Applications

E1. I have canceled a claim and renumbered the other claims during the international stage of an international application that has subsequently entered the national stage. I would like to file a preliminary amendment to the claims in the national stage of the international application, what status identifier(s) should I use for the renumbered claims? (posted August 14, 2003) (revised August 21, 2003)

Assuming that the amendment under Article 19 or 34 made during the international phase is entered in the U.S. national stage application (this will not be the case where, for example, a required English translation of the amendment is not timely furnished), the status identifier, "previously presented", should be used for renumbered claims that are not being amended in the preliminary amendment. The status identifier, "currently amended", should be used for renumbered claims that are being amended in the preliminary amendment.

For example, an applicant filed an international application that originally included independent claim 1, and dependent claims 2, 3 and 4. During the international stage, Claim 1 was amended, claim 3 was canceled, and claim 4 was renumbered as claim 3. If the amendment made during the international phase is entered in the U.S. national stage application, then a preliminary amendment adding two new claims would include a claim listing as follows:

Claim 1 (previously presented)
Claim 2 (original)
Claim 3 (previously presented)
Claim 4 (new)
Claim 5 (new)

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